

### REMARKS

Applicant has amended claim 1 in order to conform it to a proper translation of claim 1 as it appears in the German-language international application. In original international application German-language claim 1 as filed it is clear that in every state of permissible rotation about a rotation axis of the prosthesis approximately parallel to a tibial shaft when implanted, each of the condylar sliding surfaces on the femoral prosthesis part makes contact with its corresponding tibial sliding surface so that one condylar surface is in contact with the forward area of the tibial plateau (the forward slope) and the other condylar surface is in contact with the rear area of the tibial plateau (the rear slope). That is, both condylar surfaces are in contact with areas of the tibial sliding surface at all times. In claim 1 as amended these areas in front of and behind the areas of normal contact of the condylar surfaces on the tibial sliding surfaces are termed the first and second further areas. By doing this, the structure of the invention makes both condylar surfaces load-bearing in any permissible state of rotation of the tibial part about the rotation axis. The undersigned offers to present the necessary showing regarding the proper translation of the original claim language if requested. No new matter has been added, nor has the claim scope been narrowed by these amendments.

Applicant has canceled claims 3 and 6 without prejudice to moot the drawing objection and the rejection under 35 USC 112, first paragraph, relating to these claims.

On pages 2-3 of the Action, the Examiner has made lengthy comments about applicant's priority claim, suggesting that the priority claim is ineffective unless the specification is amended to refer to applicant's prior European parent application. Applicant respectfully suggests that the Examiner is mistaken.

This application is the U.S. national stage of an international application filed in the European Receiving Office and designating the United States. This international application is what the Examiner identified as "Application No. EP 03/08196, filed 7/25/03." Upon entering the national stage, applicant submitted an ADS identifying this national stage application as a

371 of the international application filed in the EPO and then indicated that applicant claimed the priority of the prior application the Examiner identified as “EP 2016768.0, filed 7/26/02.” In none of these cases is applicant relying on 35 USC 119(e), 120, 121 or 365(c); in fact, 35 USC 363 indicates that upon the entry of the application into the national stage to produce the application now before the Examiner, the application denoted “Application No. EP 03/08196, filed 7/25/03” by the Examiner has “the effect, from its international filing date \* \* \* of a national application for patent regularly filed in the [PTO], \* \* \*.” Therefore, there is no need to amend this application to refer to “Application No. EP 03/08196, filed 7/25/03” since this application is in effect the *same* application as that European PCT application. The International Bureau has transmitted the certified copy of the earlier European priority document to the PTO, so applicant need not file a separate certified copy. Applicant therefore suggests that the Examiner reconsider and withdraw his comments regarding priority on pages 2 and 3 of the Action.

In response to the drawing objection, applicant respectfully refers the Examiner to FIGS. 4 and 5 of the drawings, which show the first further areas (the areas in front of the areas of normal contact, sloping upwardly) as upwardly sloping portion 16 (see page 7, lines 10-13, of the translation), and the second further areas (the areas sloping upwardly behind the areas of normal contact) as upwardly sloping portion 17 (see page 7, lines 13-15, of the translation). FIG. 1 shows the condylar surfaces that have a radius of curvature that is substantially constant in the flexion direction as sliding surfaces 5. The original drawings were hand drawn and might not have shown this feature with exactness, but the intent of the drawings is clear from original claim 4 and page 6, lines 9-21, of the translation. The drawing objections should be withdrawn.

Claims 1 and 3-6 stand rejected as anticipated by Kaufer, and claims 1, 2, 4 and 5 stand rejected as anticipated by Crabtree. These rejections are respectfully traversed.

Although both Kaufer and Crabtree disclose structures that superficially resemble the claimed structure in having an upwardly sloping portion at the rear of the tibial plateau, these


references do not disclose structures having both the first and second further areas in front of and behind the areas of normal contact that are configured in the claimed fashion to provide a double weight bearing surface on the tibial part for both of the condylar surfaces of the femoral part even during rotation of the tibial part relative to the femoral part, as would occur if the patient receiving such an implant were to turn his or her foot. In Kaufer, the surfaces to which the Examiner refers are not configured as in the claimed invention to allow the continuous contact between both the condylar surfaces and the tibial sliding surfaces during rotation; FIG. 1 of Kaufer does not show an implant that rotates about the axis of the tibial part (as can be seen if one compares FIG. 1 with its rear and front views, FIGS. 2 and 3, respectively). Column 3, lines 19-25, of Kaufer indeed suggest that the goal of Kaufer's design is to stabilize the joint against rotation and wobbling in the extended position and not to allow the rotation that this invention provides. If the patient in whom Kaufer's prosthesis were implanted were to rotate his or her foot, there is no surface on the rear of Kaufer's tibial part on which Kaufer's femoral part would bear as in the claimed invention. Crabtree's disclosure is essentially the same as Kaufer's in these respects and thus does not anticipate the rejected claims, either. The anticipation rejections should be withdrawn.

Early action allowing claims 1, 2, 4 and 5 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 246472007300.

Dated: June 19, 2006

Respectfully submitted,

By:   
Barry E. Bretschneider  
Registration No. 28,055

Morrison & Foerster LLP  
1650 Tysons Boulevard  
Suite 300  
McLean, Virginia 22102  
Telephone: (703) 760-7743  
Facsimile: (703) 760-7777